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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/658,449

09/09/2003

Mark A. Reiley

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EXAMINER

PRONE, CHRISTOPHER D

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

04/28/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/658,449	<b>Applicant(s)</b> REILEY, MARK A.	
	<b>Examiner</b> CHRISTOPHER D. PRONE	<b>Art Unit</b> 3738	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7-18,20,22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-18,20,22 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1, 4, 5, 7-18, 20, 22, and 24-27 are pending.

Claims 25-27 are withdrawn.

Claims 2, 3, 6, 19, 21, and 23 are cancelled.

### ***Election/Restrictions***

Applicant elected Invention I and the Species of Figure 36 without traverse, on 6/12/06.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5, 7, 8, 10-12, 14, 15, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith USPN 5,092,893.

Smith discloses the invention substantially as claimed being a spinal prosthesis assembly comprising first and second prosthesis bodies 13 and 14, a fastening element 40, and removable left and right artificial facet joint structures 15, shown best in figures 1 and 2. Smith further discloses that the facet joint structures comprise a spacer 30 and

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convex surfaces to allow the joints to articulate. The examiner is interpreting the threaded connections of Smith to be mechanical frictional attachment means.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 13, 16, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith USPN 5,092,893.

Smith discloses the invention substantially as claimed being described supra. However, Smith does not disclose the materials used to make the implant or that the artificial facet joints are attached by adhesive, cement, or a Morse taper

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the connections of Smith with any of the known equivalents within the art including adhesive, cement, or Morse tapers in order to please the surgeon's preference or to accommodate different characteristics of the implant site. These connections are all well known options that would be interchangeable to one of ordinary skill in the art at the time of invention. See Wall USPN 4,502,161, for example of a bone implant teaching that adhesives and mechanical fasteners are interchangeable.

In regards to claim 20 it would have been obvious to make the implant of Smith out of the listed materials. The implant materials are well known within the art. For example, see Zang 5,314,486 wherein the prosthesis is fabricated from selected biocompatible materials including titanium, cobalt chrome and may be fastened to the bone by with roughen surface providing a bone in-growth surface medium.

In regards to claim 22, it would have been obvious to include bone growth material within the implant of Smith in order to decrease the healing time. Implant with bone growth materials are well known within the art. For example, see Burton USPN 5,282,863.

### ***Response to Arguments***

Applicant's arguments filed 2/24/11 have been fully considered but they are not persuasive. The applicant argues that Smith fails to disclose an implant comprising a joint structure that is configured to articulate. This is not persuasive because the language used to define the articulation is extremely broad and is open to numerous interpretations. The applicant fails to define what components actually articulate and with respect to what other components. One of average skill in the art could broadly interpret the language to be read upon by the entire device of Smith articulating with respect to vertebra spaced above or below the implant. The applicant failed to even define if only that portion articulates or if the entire device articulates.

Additionally one of ordinary skill in the art would recognize that the joint of smith is configured to articulate during the implantation process in order to accommodate for adjustment of the end plates.

In order to advance prosecution the applicant is advised to amend the claims to define how the joints articulate with respect to each other and claim that the full range of motion or natural movement of the spine is restored.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday through Fri 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone  
Examiner  
Art Unit 3738

/Christopher D Prone/

/CORRINE M MCDERMOTT/

Supervisory Patent Examiner, Art Unit 3738